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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/937,399	11/28/2001	Bruce McGarian	66455-202-5	9414

25269 7590 04/23/2004

DYKEMA GOSSETT PLLC
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EXAMINER

GAY, JENNIFER HAWKINS

ART UNIT	PAPER NUMBER
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3672

DATE MAILED: 04/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/937,399

Applicant(s)

MCGARIAN ET AL.

Examiner

Jennifer H Gay

Art Unit

3672

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 16-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 16-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

The After Final Amendment filed on 26 January 2004 has been entered per the Request for Continued Examination filed 09 March 2004.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 16-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over GB 2313391 in view of Braddick (US 5,595,247).

Regarding claims 16 and 17: GB 2313391 discloses a whipstock casing milling system. The system includes the following features:

- A whipstock (44) with a whipface (46).
- A first ramp surface (see Figure 4) and a second ramp surface (46) that meets the first ramp at a junction. The first ramp is relatively steep compared to the second ramp surface relative to the longitudinal axis of the whipstock so that the first ramp is disposed at a greater angle to the longitudinal axis than the second ramp.
- A window mill (32) operable to form an opening in wellbore casing (9). The milling elements of the mill directly engage the first ramp and are deflected by that ramp laterally into the casing. (See Figure 4)
The mill is attached to the whipstock by a securing means (39).

GB 2313391 discloses all of the limitations of the above claims except for a protrusion extending from the first ramp.

Braddick teaches a whipstock that includes a protrusion (260) located on the whipface (254). The protrusion is an extension of the first ramp (259) and together they

form a mill-deflecting slope. As recited in column 14, lines 54-56, the protrusion will be partially milled off during the milling operation thus the protrusion will reduce the damage to the first ramp at the junction of the first and second ramp thus the blades (262) of the mill (256) directly engage the protrusion as the mill travels from the first ramp onto the protrusion (Figures 9 and 9a). The protrusion would also move the milling elements past the first ramp thus reducing the stress on the first ramp and the whipstock.

It would have been considered obvious to one of ordinary skill in the art, at the time the invention was made, to have included the protrusion of Braddick on the whipstock of GB 2313391 in order to have protected the whipstock from being damaged (see col. 14, lines 40-58). One would have been motivated to make such a combination because a means for reducing the stress on the whipstock would have been obtained, as taught by Braddick.

Regarding claim 18: As seen in Figures 8 and 9 of Braddick, the protrusion is located on the second ramp.

Regarding claims 19 and 20: The means for securing is a shear bolt (see page 13, lines 15-27). The examiner notes that it is well known in the art that bolts are a threaded fastener.

Regarding claim 21: As seen in Figures 8 and 9 of Braddick, the protrusion includes a surface that is ramped at the same angle relative to the longitudinal axis of the whipstock as the first ramp.

Regarding claim 22: As seen in Figure 4, the angle of the first ramp surface is 15° relative to the longitudinal axis of the whipstock.

Response to Arguments

3. Applicant's arguments filed 7 October 2003 have been fully considered but they are not persuasive.

In response to applicant's argument that the nose cone of Braddick is required to protect the ramp surface (259) and that without the nose cone the mill blades would directly impact the ramp surface, while the examiner agrees with this statement, it is noted that this is essentially what applicant is claiming. The examiner further notes that,

as shown in Figures 9 and 9a, even with the nose cone the mill blades of Braddick directly engage the ramp extension (260).

In response to applicant's argument that in the absence of the nose cone, the mill blades would not contact the ramp extension (260) until they moved from the ramp surface (259) onto the ramp extension, while the examiner agrees with this statement, it is noted that this is essentially what applicant is claiming. Applicant further argues that without the nose cone, the ramp extension provides no protection to the ramp surface (259) from the mill blades. It is noted that this feature is not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Applicant has merely claimed that the protrusion offers protection at the junction of the first and second ramp, which would occur in Braddick without the nose cone.

In response to applicant's argument that it would not have been apparent to one of ordinary skill in the art that the ramp extension (260) would be divorced from the nose cone and continue to provide protection for the ramp surface, the examiner reiterates the above response that applicant has merely claimed that the protrusion offers protection at the junction of the first and second ramp, which would occur in Braddick without the nose cone.

In response to applicant's argument that the addition of a nose cone to the system of Swearingen (GB 2313391) would alter the mode of operation of Swearingen, the examiner notes that she has not suggested that the nose cone of Braddick be added to the milling system of Swearingen. Further, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

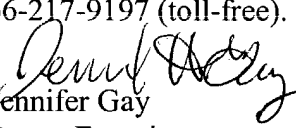
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Conclusion

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jennifer H Gay whose telephone number is (703) 308-2881. The examiner can normally be reached on Monday-Thursday, 6:30-4:00 and Friday, 6:30-1:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Bagnell can be reached on (703) 308-2151. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Jennifer Gay
Patent Examiner
Art Unit 3672


JHG

April 20, 2004